

REMARKS

In response to the Office Action mailed January 26, 2004, Applicants respectfully request reconsideration based on the following remarks. Applicants respectfully submit that the remarks contained herein place the instant application in condition for allowance and therefore, respectfully request that the rejections associated with the pending claims be withdrawn.

Claims 1, 3-20

In the Office Action, claims 1, 3-12, 18 and 20 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,259,405 to Stewart et al. ("Stewart") in view of U.S. Patent No. 6,505,046 to Baker ("Baker") and U.S. Patent No. 6,545,596 to Moon ("Moon"). In addition, claims 13-17 were rejected under 35 U.S.C. §103(a) as being unpatentable over Stewart in view of Moon. Also, the Office rejected claim 19 under 35 U.S.C. §103(a) as being unpatentable over Stewart in view of Moon and U.S. Patent No. 5,852,775 to Hidary ("Hidary"). Applicants traverse the rejections as follows.

Applicants submit that claims 1 and 13 are not obvious over Stewart, Baker and Moon because none of these references, alone or in combination, disclose, teach or suggest all the limitations set forth in the claims. In addition, Applicants also respectfully submit that no motivation or suggestion exists, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine the teachings of the references to arrive at the subject matter claimed in claims 1 and 13.

A *prima facie* case of obviousness under 35 U.S.C. §103(a) requires, among other things, that the cited references, when combined, teach or suggest every element of the claim. See

MPEP §2142. Furthermore, the teachings or suggestions must be found in the cited references and cannot be based on the Applicants' disclosure. See MPEP §§2143-2143.03. Applicants submit that the Office has not established a *prima facie* case of obviousness because not all elements of claims 1 and 13 are taught or suggested by the cited references alone or in combination.

Stewart is directed to a geographic based communications service system that, upon receipt of user identification and user location information, transmits the user identification and location information to one or more service providers. See Stewart, col. 2; lines 40-59. However, Applicants submit, as was stated on page 3 of the Office Action, that nowhere does Stewart teach, among other things, "sending one of the plurality of user-specific advertisements to the wireless communication device... over a communication network without transmitting... the location of the user therewith" as claimed in claims 1 and 13.

Baker is directed to a network that processes a mobility origination message, derives the subscriber's location and constructs a set of advertisements based on that location for a subscriber at a particular time. See Baker, col. 2; lines 8-27. However, Applicants submit that nowhere does Baker teach, among other things, "sending one of the plurality of user-specific advertisements to the wireless communication device... over a communication network without transmitting... the location of the user therewith and the plurality of location-specific advertisements to the wireless communication device... over a communication network without transmitting... the identity of the user therewith" as claimed in claims 1 and 13.

The Moon reference is also of no aid to the Office in this regard. The Moon reference involves an advertising system that determines location information and presents an

advertisement based on the location information. *See Moon*, col. 1; lines 31-38. However, like Stewart and Baker, nowhere does Moon teach, among other things, "sending one of the plurality of user-specific advertisements to the wireless communication device... over a communication network **without transmitting... the location of the user therewith**" as claimed in claims 1 and 13.

On page 3 of the Office Action, the Office states that Moon "teaches selecting user specific advertisements in a manner that would alleviate privacy concerns by incorporating anonymous association of users to audience information." *See Moon*, col. 4; lines 14-18. The Moon reference goes on to read that the disclosed invention protects the anonymity of the user by not transmitting the precise identity of the user. *See Moon*, col. 4; lines 18-25. However, the Moon reference makes no mention of protecting user anonymity by not transmitting the location of the user, and thus Applicants submit that the Moon reference does not disclose, teach or suggest, among other things, "sending one of the plurality of user-specific advertisements to the wireless communication device... over a communication network **without transmitting... the location of the user therewith**" as claimed in claims 1 and 13.

In fact, the Moon reference teaches away from not transmitting the location of the user, as claimed in claims 1 and 13. For example, in column 7, lines 1-15, the Moon reference describes a telecommunications system that not only determines the location of a telecommunications device of a user, but also **communicates the location information of the telecommunication device to other devices located throughout the communication network**. *See Moon*, col.7; lines 1-15. Thus, Applicants submit that no motivation or suggestion exists, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art,

to modify the references or to combine the teachings of the references to arrive at the subject matter claimed in claims 1 and 13

Therefore, Applicants respectfully submit that claims 1 and 13 are not obvious in view of Stewart, Baker and Moon, taken alone or in combination, because not all elements of claims 1 and 13 are taught or suggested by the cited references and no motivation exists to modify the references or to combine the teachings of the references to arrive at the claimed subject matter.

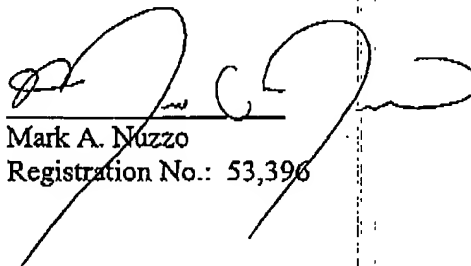
In addition, the Hidary reference also does not disclose, teach or suggest, among other things, the above-mentioned features of claims 1 and 13 nor did the Office rely upon the Hidary reference to teach such features. Thus, Applicants submit that claims 3-12, which depend from claim 1, and claims 14-20, which depend from claim 13, are not obvious in view of the cited references for the same reasons stated hereinabove. (MPEP §2143.03 states that if an independent claim is not obvious under 35 U.S.C. §103(a), then any claim depending therefrom is not obvious over the cited references). Accordingly, Applicants respectfully request that the §103(a) rejections associated with claims 1 and 3-20 be withdrawn.

Attorney Docket No. 00383  
Serial No. 09/740,373

CONCLUSION

Applicants respectfully request issuance of a Notice of Allowance for the pending claims in this application. If the Examiner is of the opinion that the instant application is in condition for disposition other than allowance, the Examiner is respectfully requested to contact the undersigned representative at the telephone number listed below in order that the Examiner's concerns may be expeditiously addressed.

Respectfully submitted,



Mark A. Nuzzo  
Registration No.: 53,396

KIRKPATRICK & LOCKHART LLP  
Henry W. Oliver Building  
535 Smithfield Street  
Pittsburgh, Pennsylvania 15222-2312

Telephone: (412) 355-6292  
Facsimile: (412) 355-6501  
e-mail: mnuzzo@kl.com